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EXAMINER

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ART UNIT	PAPER NUMBER
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3626

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/391,335

Applicant(s)

JOAO, RAYMOND ANTHONY

Examiner

Alexander Kalinowski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 305-543 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 305-543 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Claims 305-543 are presented for examination. Applicant filed a request for continued examination on 11/24/2003 along with an amendment canceling claims 150-304 and adding new claims 305-543. in light of Applicant's cancellation of claims 150-304, the Examiner withdraws the rejection of claims 150-304 based on 35 USC 103. New grounds of rejection are established in the instant office action for claims 305-543 as set forth in detail below.

Response to Arguments

2. Applicant's arguments with respect to claims 305-543 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 305-419 and 521-543 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warady et al., Pat. No. 6,067,522 (hereinafter Warady) in view of Asinof, Lynn, "Click & Shift: Workers Control Their Benefits On-line"(hereinafter Asinof)

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and Greengard, Samuel, "Building a self service culture that works" (hereinafter Greengard)..

As to claims 305, 361, and 417-419 Warady discloses a method for providing employee benefits information (see abstract), comprising:

receiving at least one of a request for an employee benefit a claim for an employee benefit, and a request for a status of a claim for an employee benefit (i.e. health and welfare benefits enrollment and billing system unit 1, modem)(col. 8, lines 27-47 and col. 10, lines 42-48);

a processing device, wherein the processing device processes the request for employee benefits and a claim for an employee benefit utilizing the employee benefits information stored in the database (i.e. employee enrollment)(col. 10, lines 55-63), wherein the employee benefits information comprises at least one of healthcare insurance information, disability insurance information, and life insurance information (col. 10, lines 55-63), and

generating a message containing a response to the at least one of a request for an employee benefits (i.e. communication between the user and the data entry and user interface module ... by modem ... confirmation may be generated to employee, employer, and respective plan providers ... modem)(col. 8, lines 27-47 and col. 10, lines 55-67) and

transmitting the message to a communication device associated with at least one of an employee, a benefits beneficiary, an employer, and a benefits administrator (i.e. communication between the user and the data entry and user interface module ... by

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modem ... confirmation may be generated to employee, employer, and respective plan providers ... modem)(col. 8, lines 27-47 and col. 10, lines 55-67).

Warady does not explicitly disclose storing at least one of pension benefits information and retirement benefits information and further wherein the processing device is capable of processing a request for employee benefits information regarding at least one of pension benefits information and retirement benefits information. wherein the processing device is capable of processing information regarding at least one of the submission of a claim for an employee benefit and the request for a status of a claim for an employee benefit.

However, Asinof discloses storing at least one of pension benefits information and retirement benefits information and further wherein the processing device is capable of processing a request for employee benefits information regarding at least one of pension benefits information and retirement benefits information (i.e. once connected, they can get real-time information on company savings or 401(K) plans ...)(page 2, paragraph 6).

Furthermore, Asinof discloses wherein the processing device is capable of processing information regarding at least one of the submission of a claim for an employee benefit and the request for a status of a claim for an employee benefit (i.e. and you'd really like to know what happened to that claim from six weeks ago for your child's visit to the emergency room)(page 1, first paragraph). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include storing at least one of pension benefits information and retirement benefits information and further wherein the processing device is capable of processing a request for employee benefits information regarding at

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least one of pension benefits information and retirement benefits information and wherein the processing device is capable of processing information regarding at least one of the submission of a claim for an employee benefit and the request for a status of a claim for an employee benefit as disclosed by Asinof within Warady for the motivation of allowing users to get benefits information at any time (i.e. employees will get information on their own timetable)(page 2, paragraphs 3 and 4) and reduce the cost of administering benefit programs to employers (page 2, paragraph 12).

Warady and Asinof do not explicitly disclose

wherein the employee benefits information includes at least one vacation time information, personal time information and sick time information.

However, Greengard discloses a method of providing employee benefits wherein the employee benefits information includes at least one of vacation time information, personal time information and sick time information (i.e. request vacation time ... on company's intranet)(page 5). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein the employee benefits information includes at least one of vacation time information, personal time information and sick time information as disclosed by Greengard within Warady and Asinof for the motivation of adding technology to automate functions to let employees handle it themselves (see abstract).

As to Claim 306, Warady does not explicitly disclose The computer-implemented method of Claim 305, wherein the message contains information regarding a providing

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of an employee benefit requested or claimed in the at least one of a request for an employee benefit and a claim for an employee benefit.

However, Asinof discloses wherein the message contains information regarding a providing of an employee benefit requested or claimed in the at least one of a request for an employee benefit and a claim for an employee benefit (i.e. shift funds)(page 2). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned features as disclosed by Asinof within Warady for the motivation stated in claims 305 above.

As to Claim 307, Warady does not explicitly disclose The computer-implemented method of Claim 305, further comprising:

providing an employee benefit requested or claimed in the at least one of a request for an employee benefit and a claim for an employee benefit.

However, Asinof discloses providing an employee benefit requested or claimed in the at least one of a request for an employee benefit and a claim for an employee benefit (i.e. shift funds)(page 2). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned features as disclosed by Asinof within Warady for the motivation stated in claims 305 above.

Claim 308, Warady discloses The computer-implemented method of Claim 305, further comprising:

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processing information regarding at least one of an employee benefit registration and an employee benefit subscription (col. 10, lines 42-54).

As to Claim 309, Warady does not explicitly disclose The computer-implemented method of Claim 305, further comprising:

processing a request for a status of the at least one of a request for an employee benefit and a claim for an employee benefit;

generating a second message in response to the request for a status of the at least one of a request for an employee benefit and a claim for an employee benefit; and

transmitting the second message to the communication device.

However, Asinof discloses processing a request for a status of the at least one of a request for an employee benefit and a claim for an employee benefit;

generating a second message in response to the request for a status of the at least one of a request for an employee benefit and a claim for an employee benefit; and

transmitting the second message to the communication device (i.e. what's happened to that claims from six weeks ago)(page 1). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned features as disclosed by Asinof within Warady for the motivation stated in claims 305 above.

As to Claim 310, Warady discloses The computer-implemented method of Claim 305, further comprising:

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processing information regarding a purchase of at least one of an enhanced employee benefit and an upgraded employee benefit (see Fig. 7a).

As Claim 311, Warady does not explicitly disclose The computer-implemented method of Claim 305, further comprising:
processing information regarding at least one of a purchase of an employee benefit and a purchase of at least one of a good, a product, and a service, pursuant to an employee benefit.

However, Asinof discloses processing information regarding at least one of a purchase of an employee benefit and a purchase of at least one of a good, a product, and a service, pursuant to an employee benefit (i.e. loan from 401(k))(page 1). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned features as disclosed by Asinof within Warady for the motivation stated in claims 305 above.

As to Claim 312, Warady discloses The computer-implemented method of Claim 305, further comprising:
processing information regarding a change to an employee benefit (col. 11, lines 33-41).

As to Claim 313, Warady does not explicitly disclose The computer-implemented method of Claim 305, wherein the employee benefits information further comprises:

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information regarding at least one of a pension benefit, a retirement benefit, an educational assistance benefit, a tuition reimbursement benefit, a credit union benefit, an employee discount program benefit, a buying service benefit, and a stock option benefit.

However, Asinof discloses information regarding at least one of a pension benefit, a retirement benefit, and a stock option benefit (see page 1 and page 2). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned features as disclosed by Asinof within Warady for the motivation stated in claims 305 above.

As to Claim 314, Warady discloses The computer-implemented method of Claim 305, wherein the communication device is at least one of a personal computer, a desktop computer, a laptop computer, a personal digital assistant, a telephone, a handheld computer, a palmtop computer, and a personal communication device (col. 13, lines 47-53).

As to Claim 315, Warady does not explicitly disclose The computer-implemented method of Claim 305, wherein the communication device is at least one of a television and an interactive television.

However, Asinof discloses wherein the communication device is at least one of a television and an interactive television (page 3). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned

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features as disclosed by Asinof within Warady for the motivation stated in claims 305 above.

As to Claim 316, Warady, Asinof and Greengard do not explicitly disclose The computer-implemented method of Claim 305, wherein the communication device is a wireless device.

However, the Examiner takes official notice that it was well known in the electronic arts to use wireless means to connect remote and central computers. The motivation was to provide network access to the service through handheld devices (i.e. PDA). It would have been obvious to one of ordinary skill in the art to include wherein the communication device is a wireless device within Warady, Asinof and Greengard for the motivation stated above.

As to Claims 316, Warady, Asinof and Greengard do not explicitly disclose The computer-implemented method of Claim 305, wherein the communication device is a kiosk.

However, the Examiner takes official notice that it was well known in the electronic human resources arts to use kiosks. The motivation would have been to provide access to services for users without network access. It would have been obvious to one of ordinary skill in the art to include wherein the communication device is a kiosk within Warady, Asinof and Greengard for the motivation stated above

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As to Claims 318 and 319, Warady does not explicitly disclose The computer-implemented method of Claim 305, wherein at least one of the computer-implemented method is utilized on or over at least one of the Internet and the World Wide Web, the at least one of a request for an employee benefit and a claim for an employee benefit is transmitted on or over at least one of the Internet and the World Wide Web, and the message is transmitted to the communication device on or over at least one of the Internet and the World Wide Web.

However, Asinof discloses wherein at least one of the computer-implemented method is utilized on or over at least one of the Internet and the World Wide Web, the at least one of a request for an employee benefit and a claim for an employee benefit is transmitted on or over at least one of the Internet and the World Wide Web, and the message is transmitted to the communication device on or over at least one of the Internet and the World Wide Web (page 3). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned features as disclosed by Asinof within Warady for the motivation stated in claims 305 above.

As to Claim 320, Warady discloses The computer-implemented method of Claim 305, wherein the processing device is at least one of a network computer, a server computer, and an Internet server computer (col. 13, lines 48-54).

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As to claim 321, Warady does not explicitly disclose The computer-implemented method of Claim 305, wherein the employee benefits information is automatically updated in real-time.

However, Asinof discloses wherein the employee benefits information is automatically updated in real-time (page 2, paragraph 6). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned features as disclosed by Asinof within Warady for the motivation stated in claims 305 above.

As to Claim 322, Warady discloses The computer-implemented method of Claim 305, wherein the employee benefits information is associated with an employment relationship (col. 4, lines 40-46).

As to Claim 323, Warady discloses The computer-implemented method of Claim 305, wherein the employee benefits information is associated with an independent contractor relationship (col. 4, lines 40-46).

As to Claim 324, Warady and Asinof do not explicitly disclose The computer-implemented method of Claim 305, further comprising:
processing information regarding a purchase pursuant to an employee discount benefit or a buying service benefit.

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However, the Examiner takes official notice that it was well known in the benefit arts to provide employee discounts. The motivation would have been to provide employees with additional benefits to encourage employee retention. It would have been obvious to one of ordinary skill in the art to include wherein the communication device is a kiosk within Warady, Asinof and Greengard for the motivation stated above.

As to Claim 325, Warady and Asinof do not explicitly disclose The computer-implemented method of Claim 305, further comprising:
processing information regarding at least one of a registration for a class or course, a request for a tuition reimbursement, and a filing of an expense account.

However, Greengard discloses processing information regarding at least one of a registration for a class or course, a request for a tuition reimbursement, and a filing of an expense account (i.e. enroll in training) (page 5). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include processing information regarding at least one of a registration for a class or course, a request for a tuition reimbursement, and a filing of an expense account as disclosed by Greengard within Warady and Asinof for the motivation stated in claim 305.

As to Claim 326, Warady discloses The computer-implemented method of Claim 305, further comprising:

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processing information regarding at least one of a selection of a primary care provider, a request for a referral authorization for a specialist, a status of a healthcare insurance claim, a purchase of a healthcare insurance benefit, a change in a healthcare insurance coverage, a status of a disability insurance claim, a purchase of a disability insurance benefit, a change in a disability insurance coverage, a status of a life insurance claim, a purchase of a life insurance benefit, and a change in a life insurance coverage (col. 5, lines 14-64).

As to claim 327, Warady, Asinof and Greengard do not explicitly disclose The computer-implemented method of Claim 305, further comprising:

processing information regarding at least one of a placing of an order with at least one of a goods provider and a services provider, a registration with at least one of a goods provider and a services provider, a subscription to at least one of a goods provider and a services provider, and a status of a pending order.

However, the Examiner takes official notice that it was well known in the electronic arts to place orders for goods and services electronically. The motivation would have been to provide access to goods and services from the comfort of a user's home or business, particularly in a system used by employees. It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include processing information regarding at least one of a placing of an order with at least one of a goods provider and a services provider, a registration with at least one of a goods provider and a services provider, a subscription to at least one of a goods provider and

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a services provider, and a status of a pending order within Warady, Asinof and Greengard for the motivation stated above.

As to Claim 328, Warady discloses The computer-implemented method of Claim 305, further comprising:

providing information to a computer associated with an employer regarding a transaction between an employee and at least one of a healthcare benefits provider, a disability benefits provider, and a life insurance benefits provider (i.e. billing)(col. 12, lines 11-37).

As to Claim 329, Warady discloses The computer-implemented method of Claim 305, wherein the processing device is linked to at least one of an employer computer, a health insurance provider computer, a disability insurance provider computer, a life insurance provider computer, a credit union or banking services provider computer, a pension benefits provider computer, a retirement benefits provider computer, and an employee discount provider computer (col. 13, lines 37-54).

As to Claim 330. Warady does not explicitly disclose The computer-implemented method of Claim 305, further comprising:

processing information regarding at least one of accessing a credit union account balance or a bank account balance, authorizing or terminating a payroll deduction, ordering checks, making a payment, stopping a payment, applying for a loan or a

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mortgage, purchasing a certificate of deposit or a bond, providing financial advice, providing information regarding a benefit offered by a credit union or a banking service provider, providing information regarding a special rate loan offered to employees, applying for a mortgage, purchasing at least one of a stock, a bond, a mutual fund, and a savings bond, providing a forecast for a savings account, providing information regarding a company stock purchase made through a company-sponsored plan, providing information regarding a savings bond purchasing plan, allocating pension funds among investment vehicles or options, changing an employee pension plan contribution, filing a pension benefits claim, determining a status of a pending pension benefits claim, allocating retirement funds among investment vehicles or options, and changing a contribution to a retirement account.

However, Asinof discloses processing information regarding at least one of accessing a credit union account balance or a bank account balance, authorizing or terminating a payroll deduction, ordering checks, making a payment, stopping a payment, applying for a loan or a mortgage, purchasing a certificate of deposit or a bond, providing financial advice, providing information regarding a benefit offered by a credit union or a banking service provider, providing information regarding a special rate loan offered to employees, applying for a mortgage, purchasing at least one of a stock, a bond, a mutual fund, and a savings bond, providing a forecast for a savings account, providing information regarding a company stock purchase made through a company-sponsored plan, providing information regarding a savings bond purchasing plan, allocating pension funds among investment vehicles or options, changing an employee

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pension plan contribution, filing a pension benefits claim, determining a status of a pending pension benefits claim, allocating retirement funds among investment vehicles or options, and changing a contribution to a retirement account (i.e. loan from your 401(k) ... shifting funds ...)(pages 1-2).). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned features as disclosed by Asinof within Warady for the motivation stated in claims 305 above.

As to Claim 331, Warady discloses The computer-implemented method of Claim 305, further comprising:

storing information regarding at least one of a benefit, a benefits package, and a benefits pricing, provided by a benefits provider, and information regarding at least one of a benefits requirement and a need for benefits associated with at least one of an employer and an employee (Fig. 1);

processing the information regarding the at least one of a benefit, a benefits package, and a benefits pricing, with the information regarding the at least one of a benefits requirement and a need for benefits (Fig. 1);

identifying a benefits provider for providing at least one of a benefit, benefits, and benefits information, for the at least one of a benefits requirement and a need for benefits (Fig. 7a);

generating a second message containing information regarding the benefits provider, wherein the second message contains information regarding the at least one of a

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benefit, a benefits package, and a benefits pricing, provided by the benefits provider (Fig. 7a); and

transmitting the second message to the communication device (Fig. 7a – 7e).

As to Claim 332, Warady discloses The computer-implemented method of Claim 305, further comprising:

receiving a request for employee benefits information (col. 8, lines 27-47);

processing the request for employee benefits information (col. 8, lines 27-52);

generating a second message in response to the request for employee benefits information (Fig. 7a- 7e); and

transmitting the second message to the communication device (Fig. 7a-7e).

As to Claim 333, Warady discloses The computer-implemented method of Claim 332, wherein the second message contains at least one of a link and a hyperlink to at least one of a computer associated with the processing device and a benefits provider computer (i.e. UNUM at (800) ...)(Fig. 8).

As to Claim 334, Warady discloses The computer-implemented method of Claim 332, wherein at least one of the employee benefits information comprises and the second message contains information regarding at least one of healthcare insurance, disability insurance, life insurance, a healthcare provider, a medical insurance provider, a dental insurance provider, a health maintenance organization, a major medical

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provider, medical insurance, major medical insurance, dental insurance, mental health insurance, prescription eye care insurance, an available healthcare insurance benefit, instructions for obtaining or claiming a healthcare insurance benefit, a health-care participant, a healthcare insurance plan coverage, a healthcare insurance benefit co-payment or deductible, a healthcare insurance benefits claim, a status of a healthcare insurance benefits claim, a disability insurance provider, a short-term disability insurance provider, a long-term disability insurance provider, an available disability insurance benefit, instructions for obtaining or claiming a disability insurance benefit, a disability insurance plan coverage, a disability insurance co-payment or deductible, a disability insurance claim, a status of a disability insurance claim, a life insurance provider, an available life insurance benefit, instructions for obtaining or claiming a life insurance benefit, a life insurance plan coverage, a life insurance co-payment or deductible, a life insurance claim, and a status of a life insurance claim (Fig. 7a-7e).

As to Claim 335, Warady and Asinof do not explicitly disclose The computer-implemented method of Claim 332, wherein at least one of the employee benefits information comprises and the second message contains information regarding at least one of a vacation time benefit, a personal time benefit, and a sick time benefit.

However, Greengard discloses wherein at least one of the employee benefits information comprises and the second message contains information regarding at least one of a vacation time benefit, a personal time benefit, and a sick time benefit (i.e.

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request vacation time ... on company's intranet)(page 5). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein the employee benefits information includes at least one of vacation time information, personal time information and sick time information as disclosed by Greengard within Warady and Asinof for the motivation of adding technology to automate functions to let employees handle it themselves (see abstract).

As to Claim 336, Warady does not explicitly disclose The computer-implemented method of Claim 332, wherein at least one of the employee benefits information comprises and the second message contains information regarding at least one of an educational assistance benefit, a tuition reimbursement benefit, a credit union benefit, an employee discount program benefit, a buying service benefit, and a stock option benefit.

However, Asinof discloses wherein at least one of the employee benefits information comprises and the second message contains information regarding at least one of an educational assistance benefit, a tuition reimbursement benefit, a credit union benefit, an employee discount program benefit, a buying service benefit, and a stock option benefit. (see pages 1-2). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned features as disclosed by Asinof within Warady for the motivation stated in claim 305 above.

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As to Claim 337, Warady does not explicitly disclose The computer-implemented method of Claim 332, wherein at least one of the employee benefits information comprises and the second message contains information regarding at least one of a pension benefit, a retirement benefit, a pension benefits provider, a pension benefits service, instructions for obtaining a pension benefit, an employee pension account, a pension benefits loan, a pension benefit available, a vested pension benefit, an unvested pension benefit, an availability of a pension benefit, a status of a pending pension benefits claim, a retirement benefits provider, an employee's retirement benefit, a retirement savings account, retirement benefits loan information, a stock account, a mutual fund account, a stock option account, a retirement benefits at least one of savings interest rate, loan interest rate, and mortgage interest rate, instructions for claiming a retirement benefit, a retirement investment vehicle, instructions for making an account deposit or a withdrawal, a deposit or withdrawal procedure, a retirement account balance, a retirement account vested amount, a retirement account unvested amount, and at least one of financial advice, planning information, and forecasting information, regarding at least one of a pension benefits account and a retirement benefits account.

However, Asinof discloses wherein at least one of the employee benefits information comprises and the second message contains information regarding at least one of a pension benefit, a retirement benefit, a pension benefits provider, a pension benefits service, instructions for obtaining a pension benefit, an employee pension account, a pension benefits loan, a pension benefit available, a vested pension benefit,

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an unvested pension benefit, an availability of a pension benefit, a status of a pending pension benefits claim, a retirement benefits provider, an employee's retirement benefit, a retirement savings account, retirement benefits loan information, a stock account, a mutual fund account, a stock option account, a retirement benefits at least one of savings interest rate, loan interest rate, and mortgage interest rate, instructions for claiming a retirement benefit, a retirement investment vehicle, instructions for making an account deposit or a withdrawal, a deposit or withdrawal procedure, a retirement account balance, a retirement account vested amount, a retirement account unvested amount, and at least one of financial advice, planning information, and forecasting information, regarding at least one of a pension benefits account and a retirement benefits account (see page 2). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned features as disclosed by Asinof within Warady for the motivation stated in claim 305 above.

As to Claim 338, Warady does not explicitly disclose The computer-implemented method of Claim 332, wherein at least one of the employee benefits information comprises and the second message contains information regarding at least one of a credit union, a bank, an available credit union or banking service, instructions for obtaining or claiming a credit union or banking benefit, an employee savings account, a loan, a mortgage, a savings interest rate, a loan rate, a mortgage rate, a provider of an employee discount, a buying service, at least one of a goods provider, a services provider, and a discount club, at least one of a good and a service offered under at least

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one of an employee discount program and a buying service program, instructions for ordering at least one of a good and a service under at least one of an employee discount program and a buying service program, and instructions for at least one of making a purchase, placing an order, obtaining customer service, and checking an order status, pursuant to at least one of an employee discount program and a buying service program.

However, Asinof discloses wherein at least one of the employee benefits information comprises and the second message contains information regarding at least one of a credit union, a bank, an available credit union or banking service, instructions for obtaining or claiming a credit union or banking benefit, an employee savings account, a loan, a mortgage, a savings interest rate, a loan rate, a mortgage rate, a provider of an employee discount, a buying service, at least one of a goods provider, a services provider, and a discount club, at least one of a good and a service offered under at least one of an employee discount program and a buying service program, instructions for ordering at least one of a good and a service under at least one of an employee discount program and a buying service program, and instructions for at least one of making a purchase, placing an order, obtaining customer service, and checking an order status, pursuant to at least one of an employee discount program and a buying service program (see pages 1-2). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned features as disclosed by Asinof within Warady for the motivation stated in claim 305 above.

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As to Claim 339, Warady discloses The computer-implemented method of Claim 332, wherein at least one of the employee benefits information comprises and the second message contains information regarding at least one of an employment status, benefits provided to an employee, instructions for obtaining or claiming a benefit, a making of a benefit election, a making of a change to a benefit, a change to an investment in at least one of a savings account, a pension account, and a retirement account, and applying for an additional benefit (i.e. confirmation of each employee's enrollment status ...)(col. 10, lines 8-22).

As to claim 340, Warady discloses The computer-implemented method of Claim 332, wherein at least one of the employee benefits information comprises and the second message contains information regarding at least one of an employee's name, an address, a social security number, a date of birth, a date of hire, a job title, a length of service, a salary, withholding taxes, an employee wage, a payroll, a salary, at least one of payroll withholding and deduction, a tax exemption status, a company stock account, a stock option account, an equity interest account, a number of dependents, federal withholding taxes, state withholding taxes, local withholding taxes, social security taxes, disability taxes, disability withholding taxes, retirement deductions, pension deductions, IRA deductions, 401K deductions, SEP deductions, savings deductions, savings bond deductions, stock purchase plan deductions, employer held savings accounts, credit union deductions, an employee savings plan or program, a 401K retirement plan or program, a selfemployed retirement plan or program, an employee credit union

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at least one of account, plan, and program, an employee savings plan or program, an employee loan plan or program, an employee discount plan or program, a buying service plan or program, a tuition reimbursement program, an educational assistance program, a child care or day care program, an inhouse training course, and a training course or educational course at least one of schedule, course description, and registration, a company announcement, a company calendar or schedule, a personnel directory, and an in-house job posting (Fig. 7a).

As to Claim 341, Warady does not explicitly disclose The computer-implemented method of Claim 332, wherein at least one of the employee benefits information comprises and the second message contains information regarding at least one of a description of a pension benefit, at least one of a vested and an unvested interest or value, an account value, and account balance, a list and a date of an employer contribution, a list and a date of an employee contribution, funds availability, an investment vehicle, an investment option, financial advice for managing a pension benefits account, at least one of a loan offering and an investment offering, a forecast for a pension account, a financial planning strategy needed to reach a goal, a company stock purchase made through a company-sponsored plan, at least one of an employer sponsored retirement account and a self employed retirement program or account, a retirement account, at least one of a list and a date of a profit sharing contribution, and a withdrawal or borrowing of monies from an account.

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However, Asinof discloses wherein at least one of the employee benefits information comprises and the second message contains information regarding at least one of a description of a pension benefit, at least one of a vested and an unvested interest or value, an account value, and account balance, a list and a date of an employer contribution, a list and a date of an employee contribution, funds availability, an investment vehicle, an investment option, financial advice for managing a pension benefits account, at least one of a loan offering and an investment offering, a forecast for a pension account, a financial planning strategy needed to reach a goal, a company stock purchase made through a company-sponsored plan, at least one of an employer sponsored retirement account and a self employed retirement program or account, a retirement account, at least one of a list and a date of a profit sharing contribution, and a withdrawal or borrowing of monies from an account (pages 1-2).). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned features as disclosed by Asinof within Warady for the motivation stated in claim 305 above.

As to Claim 342, Warady, Asinof and Greengard do not explicitly disclose The computer-implemented method of Claim 332, wherein at least one of the employee benefits information comprises and the second message contains information regarding at least one of an employee discount, a buying service, and a buying service which participates in an employee benefits program.

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However, the Examiner takes official notice that employee discount programs were well known in the benefit arts. The motivation would have been to provide additional incentives for employee retention and establish beneficial relationships with goods and service providers.). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include wherein at least one of the employee benefits information comprises and the second message contains information regarding at least one of an employee discount, a buying service, and a buying service which participates in an employee benefits program within Warady, Asinof and Greengard for the motivation stated above.

As to Claim 343, Warady discloses The computer-implemented method of Claim 332, wherein the second message contains a link to a computer associated with at least one of a healthcare benefits provider, a disability insurance benefits provider, a life insurance benefits provider, a pension benefits provider, a retirement benefits provider, an employee discount benefits provider, and a buying service benefits provider (i.e. UNUM at (800) ...)(Fig. 8).

As to Claim 344, Warady, Asinof and Greengard do not explicitly disclose The computer-implemented method of Claim 305, wherein the employee benefits information further comprises:
information regarding an employee benefit associated with an employee, wherein the employee benefit exists from a previous relationship and is maintained by the employee

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in a current employment relationship, wherein the employee benefit from the previous relationship is paid for or provided at least in part by a current employer pursuant to an employment relationship and is included in employee benefits provided to the employee by the current employer.

However, the Examiner takes official notice that it was well known in the benefit arts to roll over pension benefits when an employee changes his/her employment. The motivation would have been to continue contributions to the pension plan even if the employee switches employers.). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations within Warady, Asinof and Greengard for the motivation stated above.

As to Claim 345, Warady discloses The computer-implemented method of Claim 344, wherein the employee benefits information further comprises information regarding an individual benefits account, wherein the individual benefits account exists independently of an employment relationship (i.e. opt out because employee already has coverage)(Fig. 7a).

As to Claim 346, Warady, Asinof and Greengard do not explicitly disclose The computer-implemented method of Claim 305, further comprising:

processing information for pooling employees from different employers to obtain employee benefits for the employees of the different employers.

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However, the Examiner takes official notice that it was well known in the negotiations arts for unions to negotiate employment and benefits contracts for their members for an industry (i.e. multiple employers). The motivation would have been to standardize wages and benefits for the industry as a whole thereby ensuring standard wages and benefits for an industry and eliminating wage and benefits disparities between employers (i.e. standardizing employment costs). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations within Warady, Asinof and Greengard for the motivation stated above

As to Claim 347, Warady discloses The computer-implemented method of Claim 305, further comprising:

providing information to a computer associated with an employer regarding an employee who has at least one of upgraded a benefit and utilized at least one of a benefit offer, an employee discount benefit, and a buying service benefit (col.. 10, lines 63-67).

As to Claim 348, Warady discloses The computer-implemented method of Claim 305, further comprising:

processing information for utilizing an employer provided at least one of a fund, money, and a credit, to obtain an employee benefit from a benefits provider (col. 12, lines 16-21).

As to Claim 349, Warady discloses The computer-implemented method of Claim 305, further comprising:

processing information for utilizing an employer provided at least one of a fund, money, and a credit, to create an individual benefits account, wherein the individual benefits account exists independently of an employment relationship (i.e. cafeteria plan)(col. 4, lines 1-12),

facilitating at least one of a communication between benefits providers and a sharing of information between benefits providers (see fig. 8).

As to Claim 351, Warady, Asinof and Greengard do not explicitly disclose The computer-implemented method of Claim 305, further comprising:

utilizing at least one of an intelligent agent, a software agent, and a mobile agent, at least one of to obtain information regarding at least one of a benefit, benefit information availability, a status of a benefit, a status of a benefit claim, and a benefits provider, to request a benefit or benefits information, to request a service, to purchase at least one of a good and a service, to perform an action for or on behalf of the at least one of an employee, a benefits beneficiary, an employer, and a benefits administrator, or a benefits provider, to report at least one of a finding and an action taken, and to purchase a benefit.

transmitting at least one of a benefits request form, a benefits information request form, a claim submission form, and a claim status form, to the communication device.

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However, the Examiner takes official notice that it was well known in the electronic arts to use software agents. The motivation would have been to assist customers in searching for information of interest to the customer.). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitations within Warady, Asinof and Greengard for the motivation stated above

As to Claim 353, Warady discloses The computer-implemented method of Claim 305, further comprising:

transmitting information regarding at least one of a change to a benefit, a change to a benefits account, an activity regarding a benefits account, an offering of a benefit, a posting of an offer to sell a benefit, an advertisement for a benefit, a posting of benefits information, a posting of at least one of a need, a request, and a requirement, to obtain at least one of a benefit, a benefits package, and benefits information, a making of a payment to at least one of a deferred income savings account and a pension account, a new program, a new benefit, and a benefit discount offering, to the communication device (i.e. confirmation)(Fig. 8).

As to Claim 354, Warady discloses The computer-implemented method of Claim 332, wherein the second message contains a link to at least one of an attorney, an accountant, a management consultant, a security firm, a recruiter, an employment

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agency, an insurance provider, a financial institution, a goods provider, and a services provider (Fig. 7a-7e).

As to Claim 355, Warady discloses The computer-implemented method of Claim 305, wherein the message is contained in at least one of an electronic mail transmission, an electronic transmission, a facsimile transmission, a telephone call, a telephone message, a voice message, a pager message, and a beeper message (Fig. 7a-7e).

As to Claim 356, Warady does not explicitly disclose The computer-implemented method of Claim 305, further comprising:
utilizing at least one of an electronic power of attorney form, an electronic authorization, an electronic signature, and a digital signature, to file at least one of a medical claim form, a dental claim form, a healthcare claim form, an insurance claim form, a financial transaction form, a financial claim form, at least one of a goods order form and a service order form, and a benefit request form.

However, Asinof discloses utilizing at least one of an electronic power of attorney form, an electronic authorization, an electronic signature, and a digital signature, to file at least one of a medical claim form, a dental claim form, a healthcare claim form, an insurance claim form, a financial transaction form, a financial claim form, at least one of a goods order form and a service order form, and a benefit request form (i.e. change mix of investments)(see abstract). It would have been obvious to one of ordinary skill in

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the art at the time of Applicant's invention to include the aforementioned features as disclosed by Asinof within Warady for the motivation stated in claim 305 above.

As to Claim 357, Warady discloses The computer-implemented method of Claim 305, wherein the message is transmitted to the communication device in real-time (col. 9, line 59 – col. 10, line 8).

As to Claim 358, Warady discloses The computer-implemented method of Claim 305, further comprising:
effectuating a payment pursuant to an employee benefit in response to the at least one of a request for an employee benefit and a claim for an employee benefit (col. 12, lines 11-24).

As to Claim 359, Warady discloses The computer-implemented method of Claim 305, wherein the computer-implemented method is utilized on or over at least one of a telecommunication network, a satellite communication network, a radio communication network, a digital communication network, a digital satellite communication network, a personal communications services network, a cable television network, a broadband communication network, and a low earth orbiting satellite (LEOs) network (i.e. modem)(col. 8, lines 31-36).

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As to Claim 360, Warady discloses The computer-implemented method of Claim 305, wherein the at least one of a request for an employee benefit and a claim for an employee benefit is transmitted from the communication device (col. 13, lines 47-53).

As to claims 362-416, the claims are substantially similar in scope to claims 306-360 and are rejected on the same basis.

As to Claims 521 and 537, Warady, Asinof and Greengard disclose A computer-implemented method for providing employee benefits information as explained in claim 305 above.

In addition Warady discloses

detecting a posting of at least one of a need, a request, and a requirement, to buy or to obtain at least one of a benefit, a benefits package, and benefits information, wherein the posting of at least one of a need, a request, and a requirement, to buy or to obtain at least one of a benefit, a benefits package, and benefits information, is automatically detected by a processing device (i.e. enrollment ... modification to information...)(col. 11, lines 6-16);

generating a message containing information regarding the posting of at least one of a need, a request, and a requirement, to buy or to obtain at least one of a benefit, a benefits package, and benefits information, wherein the message is automatically generated by the processing device upon the detection of the posting of at least one of a need, a request, and a requirement, to buy or to obtain at least one of a benefit, a

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benefits package, and benefits information (i.e. modification to information ... system generates a new confirmation message)(col. 11, lines 6-16); and transmitting the message to a communication device associated with a employee and a benefit provider (i.e. plan providers)(col. 11, lines 6-16).

As to claims 522-536 and 538-543, the claims are similar in scope to claims 306-360 and are rejected on the same basis.

5. Claims 420-520 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warady in view of Asinof, Greengard and Gilbert et al., Pat. No. 6,041,313 (hereinafter Gilbert).

As to Claims 420, 468, 469 and 517, Warady, Asinof and Greengard disclose A computer-implemented method for providing employee benefits information as explained in claim 305 above.

Warady, Asinof and Greengard do not explicitly disclose

wherein the employee benefit exists from a previous relationship and is maintained by the employee in a current employment relationship, wherein the employee benefit from the previous relationship is paid for or provided at least in part by a current employer pursuant to an employment relationship and is included in employee benefits provided to the employee by the current employer.

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However, Gilbert discloses wherein the employee benefit exists from a previous relationship and is maintained by the employee in a current employment relationship, wherein the employee benefit from the previous relationship is paid for or provided at least in part by a current employer pursuant to an employment relationship and is included in employee benefits provided to the employee by the current employer (i.e. 401(k) plan ... rollover)(Fig. 17 and col. 13 lines 50-63). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned features as disclosed by Gilbert within Warady, Asinof and Greengard for the motivation of simplifying 401(k) administration thereby providing individualized participant investment accounts (col. 2, lines 1-12).

As to claims 421-467, 470-516, and 518-520, the claims are substantially similar to claims 306-360 and are rejected on the same basis.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. "Web-based HR software trickles down" discloses software that automates human resources functions.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexander Kalinowski, whose telephone number is (703) 305-2398. The examiner can normally be reached on Monday to Thursday from 9:00 AM to 6:30 PM. In addition, the examiner can be reached on alternate Fridays.

If any attempt to reach the examiner by telephone is unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached on (703) 305-9588. The fax telephone number for this group is (703) 305-7687 (for official communications including After Final communications labeled "Box AF").

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor, receptionist.



Alexander Kalinowski

Primary Examiner

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3/8/2004